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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,181	12/12/2003	Yasutoshi Nishimura	00597/0200639-US0	2581
7278	7590	12/07/2006	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			BUI, LUAN KIM	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,181

Applicant(s)

NISHIMURA ET AL.

Examiner

Luan K. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application:
- 4a) Of the above claim(s) 5-13 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 14 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 5-13 and 15-17 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/13/2006.

Applicant's "traverse" of the requirement for election of between the method of making and the product made is noted. The traversal is on the ground that "A search of the combination requires a search of the claims of both groups". This is not found persuasive because the inventions are independent and distinct from each other and because the search for the product claims do not require for the search of the method claims and because examination of each invention will necessitate disparate searches which would clearly pose a burden.

The requirement is still deemed proper and is therefore made **FINAL**.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the minute flaw must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

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be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4, 14 and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1 and 2, the phrase "bi-axially oriented polyethylene polypropylene sheet" lacks proper antecedent basis because the specification only provides a bi-axially oriented polypropylene sheet. In claim 4, the phrase "thermally fused" appears a double recitation of claim 2. In claim 14, the phrase "the polypropylene sheet" lacks proper antecedent basis. In claim 14, the phrase "... is the inner sheet of the wrapping bag" is incorrect and indefinite because Figure 3 of the instant patent application shows the polyethylene sheet is the inner sheet of the wrapping bag.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemasa et al. (5,908,113; hereinafter Takemasa'113) in view of Hetrick et al. (6,199,698; hereinafter Hetrick'698) and Parmer (2,851,212) or Salfisberg (2,012,405). To the extent that the Examiner can determine the scope of the claims, Takemasa'113 discloses a medicine wrapping machine for wrapping a medicine (Figures 1-8) comprising a medicine wrapping sheet (1) including a composite plastic sheet formed from a polypropylene sheet (2) and a polyethylene sheet (3, see abstract). Takemasa'113 further discloses an apparatus for forming a plurality of individual wrapping bags (6) from the wrapping sheet and each bag is configured to receive a medicine and the bag is separable from the wrapping sheet. Takemasa'113 also discloses the other limitations of the claims except for the sheet comprises a belt-shaped sheet includes a polyethylene terephthalate sheet and a bi-axially oriented polypropylene sheet and a minute flaw being formed on one of the sheets.

Hetrick'698 shows that it is old and conventional for constructing a pouch for a medicine comprising a sheet including a bi-axially oriented polypropylene sheet with a polyolefin layer/sheet such as polyethylene (column 1, lines 33-50). Hetrick'698 further shows a trademark Ceramis comprises a silicon oxide coated polyester preferably polyethylene terephthalate layer/sheet or polyolefin (column 4, lines 52-53). Therefore, the layer of polyolefin can be

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replaced with the layer of polyester. Parmer shows a pouch (10) having indentations (24) which is considered equivalent to a minute flaw as claimed. Salfisberg teaches a pouch for a medicine comprising two sheets (1, 2) sealed to each other and formed a minute flaw (Figures 2 and 3) at the sealed.

It would have been obvious to one having ordinary skill in the art in view of Hetrick'698 and Parmer or Salfisberg to modify the wrapping sheet of Takemasa'113 so the sheet comprises a polyethylene terephthalate sheet and a bi-axially oriented polypropylene sheet as taught by Hetrick'698 since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. With respect to the wrapping sheet comprises a belt-shaped wrapping sheet, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the wrapping sheet of Takemasa'113 so it comprises a belt-shaped as claimed or the shaped as disclosed by Takemasa'113 because the selection of the specific shape for the sheet such as belt-shaped or rectangular shaped would have been an obvious matter of design choice inasmuch as the resultant structures will work equally well. It would also have been obvious to one having ordinary skill in the art to modify the wrapping sheet of Takemasa'113 so it includes a minute flaw formed on one of the sheets as taught by Parmer or Salfisberg to facilitate holding the bag.

7. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of The German Patent No. DE 43 24 771 to Gebhardt (hereinafter Gebhardt) or Koch et al. (6,309,104; hereinafter Koch'104). The

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wrapping sheet of Takemasa'113 as modified further fails to show triangular notches being formed in both side edge parts which overlap each other when the wrapping sheet being folded in two.

Gebhardt teaches a container for medical products comprising two plastic sheets (3, 5) connected to each other (7, 9) to form a plurality of divided wrapping bags and the sheets having triangular notches/saw toothed (Figure 1). Koch'104 shows a bag (20) having triangular notches or saw-toothed shaped (Figure 1) and a minute flaw (6) (Figure 2).

It would have been obvious to one having ordinary skill in the art in view of Gebhardt or Koch'104 to modify the wrapping sheet of Takemasa'113 as modified so both side edge parts of the wrapping sheet comprises triangular notches formed in both side edge parts which overlap each other when the wrapping sheet is folded in two to facilitate opening the bags.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takemasa et al. (5,908,113; hereinafter Takemasa'113) in view of Hetrick et al. (6,199,698; hereinafter Hetrick'698) and The German Patent No. DE 43 24 771 to Gebhardt (hereinafter Gebhardt) or Koch et al. (6,309,104; hereinafter Koch'104). Takemasa'113 discloses the medicine wrapping sheet (1) as above having all the limitations of the claim except for both side edge parts of the wrapping sheet being formed in a wavy or saw-toothed shape to overlap each other when the wrapping sheet is folded in two and the sheet comprises a belt-shaped sheet includes a polyethylene terephthalate sheet and a bi-axially oriented polypropylene sheet.

Hetrick'698 shows that it is old and conventional for constructing a pouch for a medicine comprising a sheet including a bi-axially oriented polypropylene sheet with a polyolefin

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layer/sheet such as polyethylene (column 1, lines 33-50). Hetrick'698 further shows a trademark Ceramis comprises a silicon oxide coated polyester preferably polyethylene terephthalate layer/sheet or polyolefin (column 4, lines 52-53). Therefore, the layer of polyolefin can be replaced with the layer of polyester. Gebhardt teaches a container for medical products comprising two plastic sheets (3, 5) connected to each other (7, 9) to form a plurality of divided wrapping bags and the sheets having triangular notches/saw toothed (Figure 1). Koch'104 shows a bag (20) having triangular notches or saw-toothed shaped (Figure 1) and a minute flaw (6) (Figure 2).

It would have been obvious to one having ordinary skill in the art in view of Hetrick'698 and Gebhardt or Koch'104 to modify the wrapping sheet of Takemasa'113 so the sheet comprises a polyethylene terephthalate sheet and a bi-axially oriented polypropylene sheet as taught by Hetrick'698 since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. It also would have been obvious to one having ordinary skill in the art to modify the sheet of Takemasa'113 as modified so both side edge parts of the wrapping sheet is formed in a wavy or saw-toothed shape to overlap each other when the wrapping sheet is folded in two as taught by Gebhardt or Koch'104 to facilitate opening the bags.

9. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, and further in view of Parmer (2,851,212) or Salfisberg (2,012,405). The wrapping sheet of Takemasa'113 as modified further fails to show a minute flaw being formed on one of the sheets.

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Parmer shows a pouch (10) having indentations (24) which is considered equivalent to a minute flaw as claimed. Salfisberg teaches a pouch for a medicine comprising two sheets (1, 2) sealed to each other and formed a minute flaw (Figures 2 and 3) at the sealed.

It would have been obvious to one having ordinary skill in the art in view of Parmer or Salfisberg to modify the wrapping sheet of Takemasa'113 so it includes a minute flaw formed on one of the sheets to facilitate holding the bag.

Response to Arguments

Applicant's arguments with respect to 5/15/2006 have been considered but are deemed to be moot in view of the new grounds of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. **The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Formal papers and After Final communications.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lkb
December 5, 2006



Luan K. Bui
Primary Examiner
Art Unit 3728